

REMARKS

Status of Claims

Claims 9, 11, 18, 23-25, 27-29, 31, 35, 37-38, 40 and 41 are pending.

Claims 10 and 27 are canceled herein without prejudice or disclaimer.

Claims 2, 6, 33, 34, 38, 40 and 41 are amended herein. No new matter is introduced.

Interview Summary

Applicants wish to thank the Examiner for the courtesies extended to Applicants' representatives Charles Zeller and Jonathan Ball during a telephonic interview on March 24, 2008 during which the §103 rejections were discussed. No agreement was reached, though the Examiner indicated that consideration would be given to case law concerning the sufficiency of the Rule 132 Declarations of inventor Mark Garrison, filed on June 15, 2007.

Support for Amendments

Claims 38, 40, and 41 are amended to specify that the container is "re-sealable" and that the container comprises "a jar." These amendments find support throughout the application as filed, for example, on page 5, lines 12-14, which states that the "cream is preferably contained in a non-aerosol, re-sealable container, such as, for example, a tube, a bottle, jar or non-pressurized metal container."

Claims 38, 40, and 41 further specify that the jar "permits a user's fingers to be dipped into said composition." This language finds support, for example, at page 6, lines 19-25, which discloses that "the surface of the cream is disturbed or altered by, for example, a consumer's fingers/fingertips"; at page 7, lines 1-7 of the application as filed, which discloses that "every time thereafter that a consumer dips her fingers into the jar"; and at page 16, lines 29-31 which provides that "a portion of the cream is removed from the container by the consumer's fingers/fingertips."

Claims 38, 40, and 41 also are amended to specify that the jar "permits the user to see the surface of the composition contained therein" which finds support throughout the application as filed, including for example, page 5, lines 8-13 which discloses that "after each use, the aesthetic

appeal of the whipped surface texture can be self-renewed”; page 5, lines 24-28 which provides that “self-foaming action occurs at a sufficient rate that the consumer has an indication, e.g. see and hear the process occur to some degree, when they examine or apply the cream”; page 6, lines 15-16 which states that the “upper portion of the cream has a textured appearance in the container”; page 7, lines 10-14 which states that “each subsequent time that the jar is re-opened, the surface appearance of the composition . . . has renewed itself and looks like it did just before each use”; and page 7, lines 16-18 which provides that “the surface texture will appear newly whipped and re-leveled each time the jar is opened.”

Claims 38, 40, and 41 are amended to specify that the upper limit to the amount of volatile compound is about 3% by weight of the composition. This limitation finds support throughout the application as originally filed and in particular at page 11, line 13 wherein it is stated that the preferred range of volatile compound is “about 0.1 to about 3 wt%.”

Finally, claims 38, 40, and 41 are amended to raise the lower limit of the compositions viscosity to 35,000 cps which finds support on page 8, line 15 which identifies a most preferred range of “about 35,000 cps to about 75,000 cps.” The disclosure of the lower endpoint of a preferred sub-range (*i.e.*, 35,000 cps) within the broader range having an upper limit of 1,500,000 cps provides support for the instantly claims range of “about 35,000 cps to about 1,500,000 cps.” See *In re Wertheim*, 541 F.2d 257 (CCPA 1976).

Accordingly, Applicants submit that no new matter is introduced by the present claim amendments and respectfully request entry thereof.

Claim Rejections

The Examiner has rejected claims 2-7, 9-11, 18, 23-25, 27-29, 31, 33-35, 37, 38, 40 and 41 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,224,851 (“Bara”) in view of Occupational Safety and Health Administration data on ethylperfluorobutyl ether (OSHA data sheet) and U.S. Patent No. 6,528,070 (“Bratescu”).

Briefly, the Examiner contends that Bara teaches “cosmetic compositions with perfluoromethylcyclopentane,” which “can be can be replaced with ethylperfluorobutyl ether,” and which compositions may be in the form of oil-in-water emulsions. The Examiner

acknowledges that “Bara does not teach the specific viscosity of the composition,” but cites Bratescu as teaching “that the viscosity of cosmetic emulsion composition can vary from thin as 100 cps, to cream like consistency of 80,000 cps,” and asserts that “a skilled artisan would have been motivated to formulate the invention in the viscosity range of conventional cream composition well known in the art.” Finally, the Examiner states “it is obvious that the alleged ‘self-renewing property’ of the composition would have been observed by a routineer making a composition according to the teachings of the prior art.” Applicants respectfully traverse these rejections.

Initially, Applicants submit that the Examiner has not given due consideration to the Declarations under 37 C.F.R. § 1.132 of inventor Mark Garrison, filed on June 15, 2007. With respect to the Declarations, the Office Action states that the “Examiner does not find that the claimed self-renewing property of a composition confers patentability to the present composition when the claimed composition is a product made according to the teachings of a prior art.” (OA, at p. 4). This statement represents a misapplication of the law, and highlights the fact that the Examiner is impermissibly engaging in hindsight. Specifically, the self-renewing property is not an inherent feature of any prior art cited by the Examiner. Rather, the Examiner contends that a hypothetical composition that was not described in Bara and which is formed only by modifying the prior art would have such a property. However, the law is clear that **Applicants are not required to compare the claimed invention with subject matter that does not exist in the prior art.** See In re Geiger, 815 F.2d 686 (Fed. Cir. 1987). In other words, requiring Applicants to compare the claimed invention with a composition allegedly suggested by the combination or modification of the prior art is improper, as that “would be requiring comparison of the results of the invention with the results of the invention.” In re Chapman, 357 F.2d 418, 422 (CCPA 1966).

The Declarations under 37 C.F.R. § 1.132 describe testing of the composition disclosed in Example 2 of Bara and clearly demonstrate that the self-renewing property is **not**, in fact, present in that compositions. Accordingly, the Examiner’s assertion that the “‘self-renewing property’ of the composition would have been observed by a routineer making a composition according to the teachings of the prior art,” is incorrect. Reconsideration is respectfully requested.

While Applicants submit that the fact that Bara's compositions are not self-renewing is alone sufficient to overcome all rejections, the claims have been amended to specify that (i) that the container comprises "a jar that permits a user's fingers to be dipped into said composition and which permits the user to see the surface of the composition contained therein when the jar is opened," (ii) the lower limit of viscosity range is "about 35,000 cps," and (iii) the upper end of the weight range of volatile compound is "about 3%" by weight. Bara does not teach or suggest such a product.

First, the limitation that the "jar that permits a user's fingers to be dipped into said composition and which permits the user to see the surface of the composition contained therein when the jar is opened," further delineates the inventive subject matter because the benefits of the self-renewing effect are most fully realized where the user can see the surface of the composition, such as with a wide-mouth jar or the like which enables the fingers to be dipped into the composition and which enables the surface of the composition to be seen when the cap is removed.

Second, the viscosity of the composition is now limited on the lower end by 35,000 cps which is squarely within the range of creamy emulsions. The self-renewing effect is self-evident where the composition is a liquid since the surface of a liquid does not develop impressions when disturbed. However, it is wholly unexpected that a cream having a viscosity of 35,000 cps or above would be capable of self-renewing once disturbed. Without a teaching in the art that such a self-renewing cream was even possible, one skilled in the art could not have had a reasonable expectation that an oil-in-water emulsion in the form of a cream having a viscosity of about 35,000 to about 1,500,000 cps could even form a self-renewing surface.

Third, the amount of volatile compound has been limited by the present amendments to have an upper limit of 3% by weight. Bara teaches that the volatile compound is present "between 2 and 98% by weight, but preferably between 5 and 70% by weight." [col. 3, lines 18-21]. The range of 2-98% is so broad as to hardly constitute any teaching whatsoever and cannot be regarded as having the specificity necessary to suggest the instantly claimed range of 0.1-3%. Moreover, the preferred range in Bara excludes the entire claimed range and teaches away from employing the low levels of volatile compound as claimed.

Having distinguished the independent claims from the art of record, Applicants submit that the claims dependent therefrom are patentable for at least the same reasons. However, Applicants reserve the right to separately address the patentability of the dependent claims in the future, should that be necessary.

CONCLUSION

Applicants respectfully submit that the instant application is in condition for allowance. Entry of the amendments and an action passing this case to issue is therefore respectfully requested. In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

Dated: July 3, 2008

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